

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63352

Kiyoshi MATSUTANI

Appln. No.: 09/839,495

Group Art Unit: 3693

Confirmation No.: 2595

Examiner: Jason M. BORLINGHAUS

Filed: April 23, 2001

For: INFORMATION TERMINAL APPARATUS

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

Based on the information supplied by Appellant, and to Appellant's legal representatives' knowledge, the real party in interest is the assignee, Mitsubishi Denki Kabushiki Kaisha.

II. RELATED APPEALS AND INTERFERENCES

Appellant, as well as Appellant's assigns and legal representatives, are unaware of any appeals or interferences which will be directed effected by, or which directly effect or have bearing on, the Board's decision in this case.

III. STATUS OF CLAIMS

Claims 1-15 are all the claims pending in the present application. Claims 1-15 have been finally rejected, and are the subject this appeal. The pending claims are set forth in the Appendix.

IV. STATUS OF AMENDMENTS

Subsequent to the Office Action dated April 28, 2009, an Amendment was submitted on July 28, 2009, and the submitted Amendment was entered as indicated in the Advisory Action dated September 1, 2009.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The concise description of the claimed subject matter of the present invention is set forth below with regard to independent claim 1, which is one of the claims at issue in this Appeal.

The following discussion includes citations to various portions of the present application in order to aid in an understanding of the invention by reference to certain exemplary embodiments.

These citations, unless otherwise indicated, are intended only to point out supporting exemplary embodiments and are not to be construed as limiting the scope of the claims.

An exemplary embodiment of the present invention relates to an information terminal apparatus. The information terminal includes: a communication unit configured to transmit and receive information among said communication unit, a server of a credit card firm, and a server owned by a settling financial institution which settles a charge requested from said credit card firm (*e.g., Fig. 2, element 21, and first full paragraph on page 19 of specification*); a processing unit configured to execute a comparison process as to both credit card charge historical information issued from said credit card firm and balance account information saved in said settling financial institution, said credit card charge historical information being contained in the transmission and reception information of said communication unit (*e.g., Fig. 2, element 26, first full paragraph on page 19 of specification*); and an output unit configured to output comparison result information based upon the comparison process result by the processing unit (*e.g., Fig. 2, element 27, first full paragraph on page 19 of specification*).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-6 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gopinathan (U.S. Patent No. 5,819,226) and Mockett (U.S. Patent Application Publication No. 2001/0034702).
2. Claims 7 and 9-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gopinathan and Mockett, and further in view of Hassett (U.S. Patent No. 6,653,946).

VII. ARGUMENT

A. Neither Gopinathan nor Mockett renders claims 1-6 and 8 unpatentable. Specifically, neither of the applied references discloses or suggest an “apparatus” comprising the specific claim elements set forth in the claimed invention.

Appellant submits that Gopinathan discloses a system for detecting fraudulent transactions (fraudulent credit-card transaction) of credit cards, etc. using a neural network to predict the fraudulent transactions. To achieve the object of Gopinathan of detecting the fraudulent transactions, the system obtains the past transactions data of the credit card and determines if there are fraudulent transactions. The Examiner states that it is obvious to modify Gopinathan in view of Mockett, which discloses communication with a settling financial institution. Appellant respectfully disagrees.

In view of the concept of the invention of Gopinathan, obtaining information from the settling financial institution is meaningless in order to predict the fraudulent transaction. A sign of the fraudulent transaction appears in the credit-card transaction, not in the settlement information of the settling financial institution. Further, the administrator (for example, credit-card firm) of the system is not authorized to obtain the balance account information from the settling financial institution. Only the account holder (which generally corresponds to the credit-card holder) is authorized to obtain the balance account information from the settling financial institution. Therefore, one of ordinary skill in the art would not have modified Gopinathan in view of Mockett as asserted by the Examiner.

Further, according to the Examiner as indicated in the Office Action dated November 12, 2008, Mockett discloses that an “apparatus” comprises communication means (internet) for

transmitting and receiving information among the said communication means, a server of a credit card firm (credit card approval network), and a server owned by a settling financial institution. However, Mockett does not disclose what kind of data the invention thereof transmits and receives. Further, the Examiner does not point out which element of Mockett corresponds to the “apparatus”. That is, Appellant cannot know whether the “apparatus” corresponds to the user computer 12, the host computer 20 or ACH settlement process 28 of Mockett. In light of Gopinathan, the host computer 20 should be the “apparatus”. However, Mockett fails to disclose that the host computer 20 obtains the balance account information from a depository bank 14.

Yet further, as explained below, Appellant respectfully submits that there are some arguments of the Examiner that are confounding.

In the Office Action dated April 28, 2009, the Examiner re-asserts that Mockett, in its entirety, corresponds to the claimed apparatus. Further, the Examiner asserts that, “one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.”

In response, Appellant submits that the Examiner still does not show where either of the applied references, including Mockett, discloses or suggests an apparatus comprising:

“communication means for transmitting and receiving information among said communication means, a server of a credit card firm, and a server owned by a settling financial institution which settles a charge requested from said credit card firm; processing means for executing a comparison process as to both credit card charge historical information issued from said credit card firm and balance account information saved in said settling financial institution, said credit card charge historical information being contained in the transmission and reception information of said communication means; and

output means for outputting comparison result information based upon the comparison process result by the processing means.”

According to Appellant’s understanding, the above-quoted limitations are nowhere shown as part of an apparatus in the applied references, including Mockett. Furthermore, Appellant submits that they were not attacking the references individually, but were merely responding to the Examiner’s allegations about the alleged teachings of Mockett.

Yet further, first, in the Response to Arguments section of the Office Action dated April 28, 2009 (page 10, third paragraph), the Examiner cites the description of Gopinathan at col. 1, lines 20-26. As pointed out by the Examiner, Gopinathan teaches that the principals of the invention may apply to bank ATM cards in place of credit cards. However, if the principals were applied to the bank ATM cards, it might be necessary to communicate with the bank but unnecessary to communicate with the server of a credit card company. Therefore, prior art references do not teach or suggest communicating with both the server of a credit card firm and a server owned by a settling financial institution, and executing the comparison process as claimed.

Second, Appellant submits that it appears that the Examiner does not distinguish among the credit cards, bank ATM cards and the telephone calling cards.

Postpay cards such as credit cards can be used regardless of the balance of a settling financial institution, but the use of the cards is stopped if the charge cannot be withdrawn on a settlement,

As described in the summary section of the specification, the ETC (Electronic Toll Collection System) card is inserted in an on-vehicle device mounted in the vehicle and is used

for authentication via communication with a roadside apparatus. The charges are settled based on the charges on the credit card. If the charges can not be withdrawn from the credit card, the credit card and also the ETC card are invalidated. In this instance, when a user assumes that the credit card is valid or the user does not confirm the balance of the account, the user cannot become aware of the invalidity of the credit card, which may result in the ETC gate not opening and the vehicle may crash into the gate.

According to exemplary embodiments of the present invention, credit cards charge historical information, balance account information are compared, and comparison results are output (e.g., outputting warning prior to the impossibility of the settlement), such that it is possible to prevent the above-mentioned accident.

In view of the bank ATM card cited by the Examiner, the balance of an account or the history of account activity can be confirmed, but the charges which will be settled by the postpay cards can not be confirmed. Also, since the telephone calling card is generally a prepaid card, only the remaining amount can be confirmed.

That is, the cards cited by the Examiner can disclose only the available balance, which is not a card by which the credit card charge historical information (i.e., the amount of charge having been already utilized but unsettled) can be obtained.

An exemplary object of the present invention can be to warn the user prior to an invalidation of a card such as ETC cards (which may cause trouble), rather than merely confirming the balance of the account or the remaining prepaid amount.

Yet further, on the Continuation Sheet attached to the Advisory Action dated September 1, 2009, the Examiner alleges, in part:

Applicant argues that the cited prior art fail to disclose “an apparatus” that performs the claimed functions. Examiner has repeatedly mapped portions of the cited prior art to the claim limitations and has gone to great lengths to respond to the Applicant’s previous arguments. Does Applicant believe that the claimed subcomponent units (e.g. communication unit, processing unit, output unit) and the functions claimed are not present in the art? Or , based upon the working of the Applicant’s arguments, is the Applicant arguing that although the subcomponent units and functions are present in the prior art, that they are being disclosed as a system or a method, rather than an “apparatus”?

Based upon the length at which the examiner and Applicant have discussed this issue, Examiner is forced to conclude that Applicant is arguing the second issue - that the disclosed subcomponents and functions are not disclosed as being part of “an apparatus” specifically. Examiner refutes that as the prior art discloses systems composed of physical devices (apparatuses) and suggest apparatus embodiments to perform the disclosed methods. And even if such an assertion was true, it would have certainly been obvious to embody a system or method via an apparatus.

In response, Appellant acknowledges that the applied references disclose systems composed of physical devices, however nowhere do the applied references, alone or in combination, disclose or suggest a specific single apparatus (as claimed) with its attendant elements and claimed features. Multiple devices within a system or systems do not satisfy the specific features of the single claimed apparatus, as previously argued. Furthermore, in asserting that it would have been obvious to embody a system or method via an apparatus to arrive at the claimed invention, the Examiner is obviously utilizing impermissible hindsight reasoning as none of the references, alone or in combination, disclose or suggest the specific claimed features of the single apparatus.

Further, on the Continuation Sheet, the Examiner alleges, in part:

Applicant recounts portions of the specification to illustrate the differences between the Applicant's invention and the prior art. However, although the argued elements may be found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claims(s). Nor was the terminology used in the disputed claim(s) defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitation must be imported into the claims to give meaning to disputed terms. Therefore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181(Fed. Cir. 1993) and MPEP §2111.01.

In response, Appellant submits that the specification was only referred to in the Remarks of the Amendment dated July 28, 2009, for the purposes of helping to explain the differences between the claimed invention and the applied art, to the Examiner.

Therefore, at least based on the foregoing, Appellant submits that claim 1 is not obvious over the combination of Gopinathan and Mockett.

Appellant submits that dependent claims 2-6 and 8 are patentable at least by virtue of their indirect or direct dependencies from independent claim 1.

Further, with respect to claim 2, Appellant submits that the applied references, either alone or in combination, do not disclose or suggest at least, "prediction means for predicting an estimated charge amount based on said extracted periodic charge information," as recited in claim 2. In the Office Action dated November 12, 2008, the Examiner cites col. 7, line 32 - col. 8, line 35 and col. 19, lines 10-16 of Gopinathan as allegedly satisfying the above-quoted feature of claim 2. In response, Appellant submits that even if, *arguendo*, Gopinathan discloses or suggests predicting an estimated charge amount spent in each standard industrial classification

(SIC), there is no teaching or suggestion of predicting an estimated charge amount based on extracted periodic charge information. There is no teaching or suggestion of periodic charge information in the section cited by the Examiner. Further, the Examiner indicates that col. 27, lines 3-63 of Gopinathan allegedly discloses the extraction of periodic charge information. However, upon review of the cited sections of Gopinathan, clearly there is no teaching or suggestion of any estimated dollar amount spent in each SIC that is based on alleged extracted periodic charge information.

At least based on the foregoing, Appellant submits that the applied references, either alone or in combination, do not disclose or suggest each and every feature of claim 2.

With respect to dependent claim 3, Appellant submits that the applied references, either alone or in combination, do not disclose or suggest at least, “taste information extracting means for extracting taste information of a user based upon shop use historical information, facilities use historical information, or shopping historical information, which are contained in the credit card charge historical information,” as recited in claim 3. The Examiner cites col. 26, line 64 - col. 27, line 2 of Gopinathan, however there is no teaching or suggestion of the extraction of taste information of a user based upon various types of claimed information.

Appellant submits that claims 4 and 5 are patentable at least by virtue of their dependency from claim 3.

At least based on the foregoing, Appellant submits that claims 1-6 and 8 are patentably distinguishable over the applied references, either alone or in combination.

B. None of the applied references, alone in combination, renders claims 7 and 9-15 unpatentable.

Appellant submits that claims 7 and 9-15 are patentable at least by virtue of indirect or direct dependencies from independent claim 1. Hassett does not make up for the deficiencies of the other applied references.

Conclusion

In summary, at least based on the foregoing, Appellant submits that the Examiner has not demonstrated that each and every feature of the claimed invention, as set forth in claims 1-15, is taught and/or suggested by the applied references, alone or in combination. Therefore, Appellant submits that claims 1-15 are patentably distinguishable over the applied art.

The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: November 30, 2009

CLAIMS APPENDIX

CLAIMS 1-15 ON APPEAL:

1. An information terminal apparatus comprising:
communication unit configured to transmit and receive information among said communication unit, a server of a credit card firm, and a server owned by a settling financial institution which settles a charge requested from said credit card firm;
processing unit configured to execute a comparison process as to both credit card charge historical information issued from said credit card firm and balance account information saved in said settling financial institution, said credit card charge historical information being contained in the transmission and reception information of said communication unit; and
output unit configured to output comparison result information based upon the comparison process result by the processing unit.

2. An information terminal apparatus as claimed in claim 1 wherein: said processing unit comprises periodic charge information extracting unit configured to extract periodic charge information from the credit card charge historical information;
prediction unit configured to predict an estimated charge amount based on said extracted periodic charge information; and

said processing unit executes the comparison process as to said credit card charge historical information containing said estimated charge amount and said balance account information.

3. An information terminal apparatus as claimed in claim 1 wherein: said processing unit comprises:

taste information extracting unit configured to extract taste information of a user based upon shop use historical information, facilities use historical information, or shopping historical information, which are contained in the credit card charge historical information; and

providing unit configured to provide said taste information with a top priority while one of a shop and facilities are retrieved.

4. An information terminal apparatus as claimed in claim 3 wherein:

said information terminal apparatus further comprises storage unit configured to store thereinto the taste information extracted by said taste information extracting unit.

5. An information terminal apparatus as claimed in claim 4 wherein said storage unit is constituted by a non-volatile storage medium; and said storage unit is arranged in such a manner that the taste information can be replaced with respect to an external appliance, while said storage unit is detachably mounted on the information terminal apparatus, or is communicated to the external appliance.

6. An information terminal apparatus as claimed in claim 1 wherein:
said information terminal apparatus further comprises:
input unit configured to input first identification information used to specify a user; and
identifying unit configured to judge as to whether or not said user can use the credit card
based upon said first identification information entered by said input unit.

7. An information terminal apparatus as claimed in claim 6 wherein:
said input unit utilizes a remote control operation by way of a wireless communication.

8. An information terminal apparatus as claimed in claim 6 wherein:
said input unit inputs second identification information which is transmitted from the
communication unit to both the credit card firm and the server of the settling financial institution
so as to identify the user.

9. An information terminal apparatus as claimed in claim 1 wherein:
said communication unit is comprised of:
monitoring unit configured to monitor operation conditions of said communication unit;

and
warning unit configured to issue a warning notice in the case that an abnormal operation
is confirmed by said monitoring means.

10. An information terminal apparatus as claimed in claim 9 wherein:
said communication unit comprises:
releasing unit configured to release the operation of either said monitoring unit or said
warning unit by inputting thereinto third identification information used to identify the user.

11. An information terminal apparatus as claimed in claim 10 wherein when said
monitoring unit confirms the abnormal operation of the communication function under such a
state that the operation of said monitoring unit is not released by the releasing unit, the warning
notice is issued by said warning unit.

12. An information terminal apparatus as claimed in claim 10 wherein: said
communication unit is further comprised of:
positional move sensing unit configured to sense a positional move of said
communication unit; and
when said monitoring unit confirms the abnormal operation of the communication
function under such a state that the operation of said monitoring unit is not released by the
releasing unit, the warning notice is issued by said warning unit.

13. An information terminal apparatus as claimed in claim 10, wherein when at least
one of unauthorized information and incorrect information is entered into said releasing unit

under such a state that the operation of the monitoring unit is not released by the releasing unit, the warning notice is issued by said warning unit.

14. An information terminal apparatus as claimed in claim 1 wherein said information terminal apparatus is mounted on a mobile object; and
said processing unit executes a comparison process as to toll road fee historical information supplied from an electric toll collection system, the credit card charge historical information, and the balance account information.

15. An information terminal apparatus as claimed in claim 1 wherein: said information terminal apparatus is mounted on a mobile object; and
said processing unit comprises:
taste information extracting unit configured to extract taste information of the user based upon either shopping historical information or shop and/or facilities use historical information, which are contained in the credit card charge historical information, and also travel path historical information supplied from the credit card charge historical information; and
providing unit configured to provide said taste information with a top priority while one of a shop, facilities, and a route is sought.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
U.S. Appln No: 09/839,495

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EVIDENCE APPENDIX:

NONE.

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RELATED PROCEEDINGS APPENDIX

NONE.

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SUBMISSION OF APPEAL BRIEF

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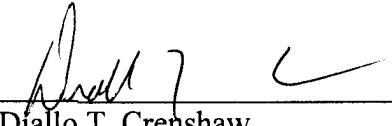
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Sir:

Submitted herewith please find an Appeal Brief. The USPTO is directed and authorized to charge the statutory fee of \$540.00 and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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